

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#12

Patent No. : 5,927,278
Application No. : 09/135,789
Patentee : Shahram Shawn Omrani
Issued : July 27, 1999
Filing Date : August 18, 1998
For : CONDOM SIMULATING VIRGINITY
Customer No. : 41245
Docket No. : SIE-191

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

RENEWED PETITION TO REINSTATE PATENT
DUE TO UNAVOIDABLE DELAY
PURSUANT TO 37 C.F.R. §1.378(b)

S I R:

This is a Renewed Petition in response to the Decision dated August 9, 2010 regarding reinstatement of the above-identified patent number 5,927,278. Patentee respectfully requests reconsideration of the petition to withdraw the expiration of the above-identified patent, which expired due to unavoidable failure to timely pay the maintenance fee, due February 27, 2007.

Patentee was represented by the late patent agent, Terrance L. Siemens, who drafted and filed the aforementioned patent application and prosecuted same prior to his death in 2006.

On October 14, 2006, Mr. Siemens' staff informed patentee that the undersigned would be able to handle future correspondence with the Office, if patentee desired. (Exhibit A)

The undersigned did not receive authorization to represent patentee nor a power of attorney from patentee to do so. Nor did the undersigned receive a copy of the aforementioned October 14, 2006 letter informing patentee of his representation options. Accordingly, the undersigned did not docket the above-identified patent for payment of maintenance fees.

Although the undersigned's mailing address (Chenango Street) was that stated in the Siemens letter of October 14, 2006, the undersigned relocated to his present location (Exchange Street) on March 1, 2008.

On August 31, 2010, Patentee was able to locate the undersigned and informed the undersigned that patentee filed a petition to reinstate his patent on October 8, 2009 (Exhibit B), but that the Office dismissed the petition on August 9, 2010 (Exhibit C).

Due to the death of patentee's former patent agent and the relocation of patentee's present attorney, communications between patentee and the undersigned were disrupted to the effect that patentee could not rely on a patent professional's obligation to inform patentee of the maintenance fee due date for the above-identified patent.

Patentee was thus unaware of his duty to pay the maintenance fee, as he received no reminder either from the Office or from his recently deceased representative. Accordingly, the delay for maintenance fee payment was unavoidable.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true: and further that these statements were made, with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Patent No. 5,927,278
Petition dated October 11, 2010

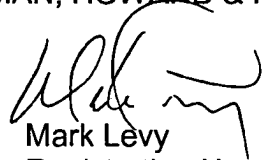
The Director is hereby authorized to charge a fee of \$400 for this petition to the undersigned's deposit account number 50-3721.

Respectfully submitted,

HINMAN, HOWARD & KATTELL, LLP

Dated: October 11, 2010

By:



Mark Levy
Registration No. 29188
Attorney for Patentee
80 Exchange Street
P.O. Box 5250
Binghamton, NY 13901
Phone: (607) 231-6991

Exhibit A

Siemens Patent Services
P.O. Box 2607 · Fairfax, VA 22031
(540) 548-4404

October 14, 2006

Mr. Shahram Shawn Omrani
11 Idaho Street
Passaic, New Jersey 07055-3336

Re: Patent Number 6,073,899 and 5,927,278

Dear Mr. Omrani:

We would like to inform you that Siemens Patent Services is closing its doors. Since your Patent(s) have already issued, all that remains to be done is the periodic payment of maintenance fees, as you may already know.

In order for you to remain up to date on your Maintenance fees, we are forwarding the information regarding your issued Patent(s) to Mark Levy of Mark Levy & Associates at 19 Chenango St. #902, Binghamton, NY 13901 (607) 722-6600, so that he can further assist you when your Maintenance Fees are due.

Accordingly a Change of Correspondence Address form is enclosed for each of your issued Patent(s). Please sign, print your name, telephone number and the date on the three bottom lines of the form(s) and return it to Mr. Levy in the enclosed envelope (not stamped) so it can be filed at the United States Patent and Trademark Office (USPTO). This will allow the Maintenance Fee notices to be sent to Mr. Levy to facilitate the process. Please note the Maintenance Fee schedule on the inside cover of your original patent.

Please note that if you have more than one patent, a separate form is enclosed for each one.

Please be sure to keep Mark Levy and/or the USPTO informed of any address changes so they can reach you during the duration of your patent.

We thank you for having had the opportunity to work with you on your patent.

Sincerely,
SIEMENS PATENT SERVICES

Exhibit B

Manzer, Amy

From: Manzer, Amy
Sent: Tuesday, August 31, 2010 11:04 AM
To: 'michieomr@aol.com'
Subject: Patents
Importance: High
Attachments: SIE-190 POA.pdf; SIE-189 POA.pdf
Mr. Omrani —

Following up to our telephone conversation, I have assigned docket number SIE-189 to your patent number 5,927,278. Please reference this number in future correspondence. I have attached a form for your signature. Please sign the form and return it to me for filing at your earliest convenience, in addition to sending us the correspondence as discussed.

In addition, I found patent number 6,073,899 issued in your name. If you would like us to represent you in regards to that case as well, please sign the attached form (SIE-190) and return it to me. We will then add that file to our database and inform you of future fees.

If you have any questions, please call our office.

Regards,

Amy Manzer
Paralegal to Mark Levy, IP Counsel

HINMAN, HOWARD & KATTELL, LLP
80 Exchange Street
P.O. Box 5250
Binghamton, NY 13901

Tel: (607) 231-6830
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8/31/2010

Exhibit C



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 11

Shahram Shawn Omram
11 Idaho St.
Passaic NJ 07055

MAILED

AUG 09 2010

In re Patent No. 5,927,278

Issued: July 27, 1999

Application No.: 09/135,789

Filing Date: August 18, 1998

Attorney Docket No.

: ON PETITION

OFFICE OF PETITIONS

This is in response to the response to the "Request for Information" filed February 23, 2010, and the prior filed petition under 37 CFR 1.378(b) filed October 8, 2009.

The petition is **dismissed**.

The patent issued July 27, 1999. The 7.5 year maintenance fee could have been paid from July 27, 2006, through January 27, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from January 28, 2007, to July 27, 2007. Petitioner did not do so. Accordingly, the patent expired at midnight on July 27, 2007.

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b).

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.¹

¹The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee . . . at any time . . . if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F. Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion Rule 36), 937 F.2d 623 (Fed Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d agencies' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or

However, "[t]he question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."² Nonawareness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP, or the Official Gazette notices does not constitute unavoidable delay.³ The statute requires a "showing" by petitioner, therefore; petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Petitioner is responsible for possessing knowledge of the need to pay maintenance fees and the due dates for such fees, Petitioner is responsible for instituting a reliable docketing system to remind him or her when maintenance fees become due.

Petitioner is responsible for having knowledge of the need to pay maintenance fees and knowing when the fees are due.⁴ The Office has no duty to notify a patentee of the requirement to pay maintenance fees or to notify patentee when a maintenance fee is due.⁵ Even if the Office were

ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."')

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F. 3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1781 (Fed. Cir. 1995) (Citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990); Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P. Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat 31, 32-33 (1887)).

²Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³See Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable delay"); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (plaintiffs, through their counsel's action, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

⁴Nonawareness of PTO statutes, PTO rules, the MPEP, or Official Gazette notices, which state maintenance fee amounts and dates they are due does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs, through their counsel's actions, or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Petitioner must act as a reasonable and prudent person in relation to his most important business. Upon obtaining the patent, a reasonable and prudent person, in relation to his most important business, would become familiar with the legal requirements of that business, in this case, the requirement to pay maintenance fees. In addition, a reasonable and prudent individual would read the patent itself and thereby become aware of the need to pay maintenance fees and the fact that such fee amounts are sometimes changed by law or regulation.

⁵Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) . . . [T]he Commissioner's no timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist. LEXIS 21478, 8-9 (1994), *aff'd on other grounds* Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995) (Citing

required to provide notice to applicant of the existence of maintenance fee requirements. such notice is provided by the patent itself.⁶

A reasonable and prudent person, aware of the existence of maintenance fees, would not rely on maintenance fee reminders or on memory to remind him or her when payments would fall due several years in the future. Instead, such an individual would implement a reliable and trustworthy tracking system to keep track of the relevant dates.⁷ The individual would also take steps to ensure that the patent information was correctly entered into the tracking system.

Application of the unavoidable standard to the present facts

In the instant petition, petitioner argues that the above-cited patent should be reinstated because the delay in paying the 7.5 year maintenance fee was the result of the failure of the patentee's patent attorney, Terrance L. Siemens, to pay the maintenance fee despite the patentee having provided Mr. Siemens with the monies to pay the 7.5-year maintenance fee. Petitioner further maintains that petitioner was unaware of Mr. Siemens death which contributed to the entire delay in paying the 7.5-year maintenance fee and filing a grantable petition. Further to this point, Section 2590 of the *Manual of Patent Examining Procedure* (MPEP) provides that, among other requirements, a petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

(C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

Rydeen v. Quigg, 748 F. Supp. 900, 905 (1990), *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 81 L. ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in *Rydeen*, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute.'" *Id.* at 3 (citing *Rydeen v. Quigg*, 748 F. Supp. at 906, *Texaco v. Short*, 454 U.S. 516, 536; 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)).

The Patent Office, as a courtesy tries to send maintenance fee reminders and notices of patent expiration to the address of record. However, the failure to receive the reminder notice, and the lack of knowledge of the requirement to pay the maintenance fee, will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. See MPEP 2575, 2540, 2590. Petitioner does not have a right to a personalized notice that this patent will expire if a certain maintenance fee is not paid, as the publication of the statute was sufficient notice. See *Rydeen v. Quigg*, 748 F. Supp. 900, 907 (1990). the ultimate responsibility for keeping track of maintenance fee states lies with the patentee, not the USPTO. Since the mailing of Notices by the Office is completely discretionary and not a requirement imposed by Congress, accepting an argument that failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the policy. All petitions could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

⁶See *Ray v. Lehman*, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters of Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

⁷ 37 CFR 1.378(b)(3) precludes acceptance of a late maintenance fee for a patent unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. The federal Circuit has specifically upheld the validity of this regulation. *Ray v. Lehman*, 55 F.3d 606, 609; 34 USPQ2d (BNA) 1786 (Fed.Cir. 1995). In *Ray v. Lehman*, petitioner claimed that he had not known of the existence of the maintenance fees and therefore had no steps in place to pay such fees. The petitioner therefore argues that the PTO's regulation, 37 CFR 1.37(b)(3), supra, arguing that it 'creates a burden that goes well beyond what is reasonably prudent.' We disagree. The PTO's regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." *Id.*

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

As the crux of petitioner's arguments rest on the failure of Mr. Siemens and firm to pay the 7.5-year maintenance fee, it necessary for petitioner to establish that the delay of Mr. Siemens and, if applicable, his firm was unavoidable. Accordingly, petitioner must provide a statement from a person from this firm with first hand knowledge of the failures that contributed to the non-payment of the 7.5-year maintenance fee. At a minimum, petitioner must provide a statement from Mr. Mark Levy who petitioner indicates contributed to the delay in paying the 7.5-year maintenance fee.

A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. This would include a statement from the patent owner regarding the payment of the maintenance fee funds to Mr. Siemens and his firm and any details of any follow-up conversations that the patent owner may have had regarding payment of the maintenance fee.

Petitioner should provide an explanation of the arrangement between the patent owner and Mr. Siemens and his firm. The explanation should detail who was responsible for tracking the payment of the maintenance fees and remitting the maintenance fee to the USPTO. If available, petitioner should provide documentary evidence of this arrangement, namely a copy of the retainer agreement between the patent owner and Mr. Siemens. Petitioner should also provide documentary evidence that the funds for the maintenance fee were timely remitted to Mr. Siemens for payment to the USPTO.

In general, absent evidence that the attorney/agent acted to deceive the client, the patent owner is bound by the actions or inactions of its duly authorized and voluntarily chosen representatives. Specifically, the patent owners delay caused by the mistake or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133. Thus, petitioner must establish, through statements and documentary evidence, that petitioner's duly authorized representative acted willfully to deceive the patent owner such that the 7.5 year maintenance fee would not be timely paid.

Petitioner's argument relative to petitioner's mother's health is noted, but does not appear to be relevant to the delay in paying the 7.5 year maintenance fee because it appears that petitioner delegated the responsibility of paying the 7.5 year maintenance fee to a registered patent agent. Thus, the focus of this petition is largely on the actions or inactions of Mr. Siemens and his firm.

Regarding patentee's assertion that the delay in paying the 7.5-year maintenance fee was exacerbated by patentee's failure to receive a maintenance fee reminder, section 2590 of the *Manual of Patent Examining Procedure* (MPEP) specifically states, in pertinent part, that:

... the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to ensure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a

Maintenance fee from the patentee to the Office.

While the patentee's failure to receive a maintenance fee reminder is regrettable, the failure to pay a maintenance fee based on the lack of knowledge of the need to pay it does not satisfy the unavoidable standard of 37 CFR 1.378(b).

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision.⁸ The petition for reconsideration should be titled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration for this decision must be accompanied by a non-refundable petition fee of \$400.00 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. It is, therefore, extremely important that petitioner supply any and all relevant information and documentation with the request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence "to show" that the delay was unavoidable. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

By facsimile: (571) 273-8300
Attn: Office of Petitions

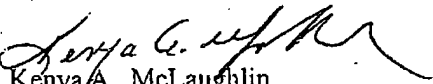
A reasonable and prudent person would not rely on maintenance fee reminders from the Office for two reasons. First, the Office has indicated that such reminders are a mere courtesy and has reserved the right to discontinue such reminders at any time. second, such reminders may be lost in the mail. A reasonable and prudent person, in regard to his most important business would not rely solely on reminders that the Office may or may not send which may or may not be lost in the mail.

⁸No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704.

In re Patent No. 5,927,278

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Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.



Kenya A. McLaughlin
Petition Attorney
Office of Petitions